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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,229	03/05/2002	Margit Hiller	DIV 87/000031	6890
26474	7590	11/25/2003	EXAMINER	
KEIL & WEINKAUF 1350 CONNECTICUT AVENUE, N.W. WASHINGTON, DC 20036				HAMILTON, CYNTHIA
ART UNIT		PAPER NUMBER		

10

DATE MAILED: 11/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/090,229	HILLER ET AL.	
	Examiner Cynthia Hamilton	Art Unit 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 9/12/03, 8/7/03.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 10-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 10,13,15 and 18-20 is/are rejected.
- 7) Claim(s) 11-12, 14, 16-17 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. Claims 10, 13, 15, 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Notsu et al (EP 0 666 184 A1). In Notsu et al, see particularly page 4, lines 3-16, page 5, lines 2-18, page 6, lines 35-37 and Examples 4-6 and 9-10. Notsu et al disclose printing plate precursors in Examples 4-6 and 9-10 wherein silicone compounds are present as a water repellant along with carbon black. These plates are to be used in gravure printing, flexo printing, etc. thus are used in relief printing. See Notsu et al on page 7, lines 8-10. The examples of Notsu et al do not anticipate the instant plates, but instead make them obvious in view of their teachings on page 6, wherein in lines 32-35, the thickness of the photosensitive, i.e. ablative, layer, of Notsu et al is

from 1 to 100 um or from 0.001 to 0.1 mm. The top of the range of 0.1 mm overlaps the instant range at 0.1 mm or 100um. The plates of Notsu et al are disclosed to include flexographic plates and relief plates, thus with respect to instant claims 10, 13, 15, 18-20, to laser engrave plates with laser engraveable layers up to 0.1 um thick as taught feasible by Notsu et al with silicone rubber present in the laser engravable layer as taught as water repellant on page 5, lines 26-39 in the range of 0.1 to 5 parts by weight would have been *prima facie* obvious as would be the assumption laser engraving occurred in air, i.e. a gas with oxygen present. See particularly MPEP 2144.05. In the case where the claimed ranges “overlap or lie inside ranges disclosed by the prior art” a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). The examiner notes applicants call the silicone rubber a binder but do not exclude other components from the laser-engageable layer, thus the silicone rubber even though called by another name by Notsu et al inherently has the ability to act as a binder in the plates of the prior art. With respect to the presence of silicone rubber in the layer in question, Notsu et al on page 5, lines 2-17 disclose silicone rubber as one choice of compound present. Applicants added “consisting essentially of” to “...wherein said polymeric binder consists essentially of a silicone rubber...”. Since applicants have not shown the introduction of the additional binders of Notsu et al would materially change the characteristics of applicant’s invention, the examiner has treated “consisting essentially of” as “comprising” for examination purposes. For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, “consisting essentially of” will be construed as equivalent to “comprising.” See, e.g., *PPG*, 156 F.3d at 1355,

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48 USPQ2d at 1355. If an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the bur-den of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). With respect to 75%, of the polymeric binder being silicone rubber, the examiner notes that the polymeric binder of claim 10 is the "at least one polymeric binder of which the laser- engraveable recording layer is comprised. The examiner notes that there is no limit of this 'at least one polymeric binder' being the only polymeric binder in said layer. Thus, the at least polymeric binder is the silicone rubber and thus it is 100% silicone rubber binder. The examiner does note that if all of the polymeric binder were at least 75% silicone rubber in said layer that this would be unobvious over Notsu et al.

2. Claims 11-12, 14, and 16-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

3. Applicant's arguments filed August 27, 2003 have been fully considered but they are not persuasive. Applicants argue, "It should further be noted that Notsu discloses a printing plate precursor wherein the binder "consists essentially of " (in the above noted sense) *nitrocellulose* and polyester as binder... Clearly, nitrocellulose with a polyester as the principle binder would materially affect the *basic and novel characteristics* of applicants' plates in which the principle binder is a silicone rubber." Applicants further argue that the silicone rubbers are not 'binders' in Notsu but "water repellant" and that the amounts of it used of 0.1-5%. This is given as evidence that Notsu used the silicone rubber as an additive and not as "principle binder as do

applicants.” The examiner has already noted that the burden lies with applicant to show the addition of other binders would materially affect the basic and novel characteristics of applicant’s plates. Applicants have not written the claim language in a manner as to exclude other binders. The wording is (using claim 12) “a laser-engravable recording layer comprising at least one polymeric binder and at least one absorber for laser radiation, wherein said polymeric binder consists essentially of a silicone rubber and said absorber is....”. Thus, what “consists essentially of” is the “said polymeric binder”. The wording in the claim language does not exclude other binders because “comprising at least one polymeric binder” is the limit on the layer. There is no “consisting essentially of one polymeric binder”. The limit of “consists essentially of” is only on the “at least one polymeric binder”. This language in any form does not limit other binders. Thus, even binders that materially effect the instant invention are not excluded. The wording does not put this limit on the process set forth. The rejection stands as modified due to applicant’s amendments.

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

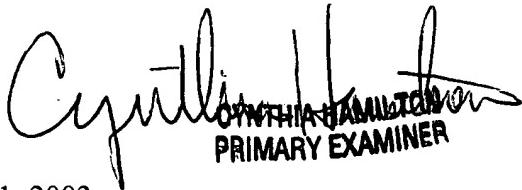
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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Cynthia Hamilton whose telephone number is (703) 308-3626. As of December 12, 2003, this telephone number will be 571-272-1331. The examiner can normally be reached on Monday-Friday, 9:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff can be reached on 703-308-2464. As of December 12, 2003 this phone number will be 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305 0661.



Cynthia Hamilton
CYNTHIA HAMILTON
PRIMARY EXAMINER

Primary Examiner Cynthia Hamilton

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November 21, 2003